

**Appeal Brief**  
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Dated: October 30, 2009

Signature: Lisa deCordova  
(Lisa deCordova)

Docket No.: 65003/P002US/10312242  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Ajay R. Bam et al.

Application No.: 10/691,459

Confirmation No.: 7339

Filed: October 22, 2003

Art Unit: 3688

For: SYSTEM AND METHOD OF GENERATING,  
DISTRIBUTING, AND/OR REDEEMING  
PROMOTIONAL OFFERS USING  
ELECTRONIC DEVICES

Examiner: K. H. Le

**APPEAL BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is being filed within two (2) months of the filing date of the Notice of Appeal filed in this case on August 31, 2009, and is in furtherance of the Notice of Panel Decision from Pre-Appeal Brief Review mailed on September 14, 2009.

The fees required under 37 C.F.R. § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

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**I. REAL PARTY IN INTEREST**

The real party in interest for this appeal is:

MODIV MEDIA, INC.

**II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS**

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

**III. STATUS OF CLAIMS**

**A. Total Number of Claims in Application**

There are 64 claims pending in application.

**B. Current Status of Claims**

1. Claims canceled: 6,15,23,24,25,42,43,51,64
2. Claims withdrawn from consideration but not canceled: 74,75
3. Claims pending: 1-5,7-14,16-22,26-41,44-50,52-63,65-73
4. Claims allowed: 0
5. Claims rejected: 1-5,7-14,16-22,26-41,44-50,52-63,65-73

**C. Claims On Appeal**

The claims on appeal are claims 1-5,7-14,16-22,26-41,44-50,52-63, and 65-73.

**IV. STATUS OF AMENDMENTS**

Applicant filed an Amendment After Final Rejection on July 29, 2009 including amendments to address the Examiner's specific issues concerning the outstanding 35 U.S.C.

§ 101 rejection. The Examiner responded to the Amendment After Final Rejection in an Advisory Action mailed August 11, 2009. In the Advisory Action, the Examiner indicated that Applicants' proposed amendments to claims 1-5,7-14,16-22,26-41,44-50,52-63, and 65-73 would not be entered.

Accordingly, the claims enclosed herein as Appendix A do not incorporate the amendments to claims 1-5,7-14,16-22,26-41,44-50,52-63, and 65-73, as indicated in the paper filed. However, the claims in Appendix A do incorporate the amendments indicated in the paper filed by Applicant on February 17, 2009.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each independent claim involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R. § 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. However, the citation to passages in the specification and drawings does not imply that the limitations from the specification and drawings should be read into the corresponding claim element.

According to independent claim 1, one embodiment of the claimed subject matter is a method for distributing a promotion (page 4, lines 10-19, page 9, line 29 to page 10, line 6, page 11, line 28 to page 12, line 7, Fig. 1 – item 10, Fig. 4 – items 401 to 407) comprising generating a promotion for use by a specific consumer (page 2, lines 20-29, page 8, line 19 to page 9, line 2, page 9, line 29 to page 10, line 6, page 10, line 28 to page 11, line 7, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 101; Fig. 4 – item 401), wirelessly transmitting data relating to the promotion to a mobile electronic device of the specific consumer (page 6, lines 5-29, page 8, line 19 to page 9, line 2, page 9, lines 16-28, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 11, 12, 14, Fig. 4 – item 402) and wirelessly applying the promotion to a purchase using the mobile electronic device (page 7, lines 1-8, page 7, line 22 to page 8, line 15, page 9, lines 16-28, Fig. 1 – item 11).

According to dependent claim 3, a further embodiment of claimed subject matter is the method of independent claim 1 further comprising receiving a response from the mobile

electronic device of the specific consumer redeeming the promotion, wherein the response is received wirelessly (page 7, lines 1-8, page 7, line 22 to page 8, line 8, page 9, lines 9-28, page 10, lines 7-17, Fig. 1 – item 11; Fig. 2 – item 203).

According to dependent claim 7, a further embodiment of claimed subject matter is the method of independent claim 1 is where the transmitted data is a text message (page 4, line 20 to page 5, line 2, page 5, lines 16-21, page 5, line 27 to page 6, line 4, page 9, lines 9-28, page 10, lines 7-17, page 10, lines 21-27, Fig. 1 – item 11, Fig. 2 – item 203).

According to dependent claim 8, a further embodiment of claimed subject matter is the method of independent claim 1 where the transmitted data is a voice mail message (page 9, lines 3-8, page 10, line 28 to page 11, line 16, Fig. 1 – item 11, Fig. 3 – item 304).

According to independent claim 13, one embodiment of the claimed subject matter is a method of wirelessly receiving and redeeming promotions via a mobile electronic device comprising accessing, with the mobile electronic device, data, relating to the promotion, wirelessly transmitted to the mobile electronic device from a server (page 6, lines 5-29, page 8, line 19 to page 9, line 2, page 9, lines 16-28, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 11, 12, 14; Fig. 4 – items 403, 404), redeeming the promotion by wirelessly replying to the server using the mobile electronic device (page 7, lines 1-8, page 7, line 22 to page 8, line 8, page 9, lines 9-28, Fig. 1 – items 10, 11, 13, 15, 17) and saving the redeemed promotion to an electronic account (page 2, lines 20-29, page 3, lines 1-4, page 5, line 27 to page 6, line 4, page 10, lines 7-17, page 10, line 28 to page 11, line 7, page 11, lines 17-20, Fig. 1 – items 10, 13; Fig. 2 – item 204; Fig. 3 – item 305).

According to dependent claim 16, a further embodiment of the claimed subject matter is the method of independent claim 13 where the consumer wirelessly requests the promotion from the server by using the mobile electronic device (page 5, line 27 to page 6, line 4, page 9, line 29 to page 10, line 17, page 10, line 28 to page 11, line 7, Fig. 1 – items 10, 11; Fig. 3 – item 301).

According to dependent claim 21, a further embodiment of the claimed subject matter is the method of independent claim 13 where redeeming is by telephone, text message, or multi-media message (page 4, line 10 to page 5, line 2, page 5, lines 16-21, page 5, line 27 to

page 6, line 4, page 9, lines 9-28, page 10, lines 7-17, page 10, lines 21-27, page 11, lines 21-27, Fig. 1 – items 10, 11; Fig. 2 – item 202; Fig. 3 – item 302).

According to independent claim 22, another embodiment of the claimed subject matter is a method of distributing a promotion comprising generating a promotion for use by a consumer (page 2, lines 20-29, page 8, line 19 to page 9, line 2, page 9, line 29 to page 10, line 6, page 10, line 28 to page 11, line 7, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 101; Fig. 4 – item 401), sending promotion data to a consumer web portal wirelessly accessible on a mobile electronic device of the consumer (page 2, lines 20-29, page 6, lines 15-29, page 8, line 19 to page 9, line 2, Fig. 1 – items 10, 11), and saving the promotion in a promotion saving account accessible by the mobile electronic device (page 2, lines 20-29, page 3, lines 1-4, page 5, line 27 to page 6, line 4, page 10, lines 7-17, page 10, line 28 to page 11, line 7, page 11, lines 17-20, Fig. 1 – items 10, 13; Fig. 2 – item 204; Fig. 3 – item 305) when the consumer wirelessly redeems the promotion using the mobile electronic device for a purchase at a point of sale (POS) (page 7, lines 1-8, page 7, line 22 to page 8, line 8, page 9, lines 9-28, Fig. 1 – item 11).

According to independent claim 26, another embodiment of the claimed subject matter is a method for wirelessly distributing a promotion to a mobile electronic device of a targeted consumer (page 2, lines 20-29, page 8, line 19 to page 9, line 2, page 9, line 29 to page 10, line 6, Fig. 1 – item 10) comprising generating the promotion for use by the targeted consumer (page 2, lines 20-29, page 8, line 19 to page 9, line 2, page 9, line 29 to page 10, line 6, page 10, line 28 to page 11, line 7, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 101; Fig. 4 – item 401), wherein the targeted consumer is selected from a plurality of potential consumers (page 2, lines 20-29, page 8, line 19 to page 9, line 2, page 9, line 29 to page 10, line 6), and wirelessly transmitting data relating to the promotion to the mobile electronic device of the consumer (page 6, lines 5-29, page 8, line 19 to page 9, line 2, page 9, lines 16-28, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 11, 12, 14; Fig. 4 – items 403, 404).

According to independent claim 30, another embodiment of the claimed subject matter is a method of wirelessly distributing a promotion to a mobile electronic device of a requesting consumer comprising generating a promotion for use by the requesting consumer

(page 2, lines 20-29, page 8, line 19 to page 9, line 2, page 9, line 29 to page 10, line 6, page 10, line 28 to page 11, line 7, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 101; Fig. 4 – item 401), wherein the requesting consumer is prompted to request the promotion (page 9, line 29 to page 10, line 6, Fig. 1 – item 11), and wirelessly transmitting data relating to the promotion to the mobile electronic device of the requesting consumer (page 6, lines 5-29, page 8, line 19 to page 9, line 2, page 9, lines 16-28, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 11, 12, 14; Fig. 4 – items 403, 404).

According to dependent claim 33, a further embodiment of the claimed subject matter is the method of independent claim 30 where the requesting consumer contacts a distributor to request the promotion using the mobile electronic device (page 5, line 27 to page 6, line 4, page 9, line 29 to page 10, line 17, page 10, line 28 to page 11, line 7, Fig. 1 – items 10, 11; Fig. 2 – item 201, Fig. 3 – item 301).

According to dependent claim 35, a further embodiment of the claimed subject matter is the method of dependent claim 34 where the requesting consumer contacts the distributor via the mobile electronic device by calling a telephone number, sending an email message, or sending a text message (page 4, line 20 to page 5, line 2, page 5, lines 16-21, page 5, line 27 to page 6, line 4, page 9, lines 9-28, page 10, lines 7-17, page 10, lines 21-27, Fig. 1 – items 10, 11; Fig. 2 – item 202; Fig. 3 – item 302).

According to independent claim 37, another embodiment of the claimed subject matter is a method for distributing a promotional offer to a targeted consumer (page 2, lines 20-29, page 8, line 19 to page 9, line 2, page 9, line 29 to page 10, line 6, Fig. 1 – item 10) comprising wirelessly transmitting an offer to a mobile electronic device of a targeted consumer (page 6, lines 5-29, page 8, line 19 to page 9, line 2, page 9, lines 16-28, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 11, 12, 14; Fig. 4 – items 403, 404), wherein the targeted consumer is selected from a plurality of potential consumers (page 2, lines 20-29, page 8, line 19 to page 9, line 2, page 9, line 29 to page 10, line 6), receiving a reply from the mobile electronic device of the targeted consumer in response to the promotional offer (page 9, lines 9-28, Fig. 1 – item 11) and facilitating a purchase by the targeted consumer, the purchase correlated to the promotional offer (page 7, lines 1-8, page 9, lines 16-28, page 10,

lines 21-27, page 11, lines 8-16, page 11, lines 21-27, Fig. 1 – items 10, 11; Fig. 2 – items 204 to 209).

According to independent claim 41, another embodiment of the claimed subject matter is a system for distributing and redeeming a promotion (page 7, lines 1-8, page 7, line 22 to page 8, line 8, page 9, lines 9-28, Fig. 1 – item 10). The system comprises a processor for generating promotion data (page 2, lines 20-29, page 6, lines 15-29, page 8, line 19 to page 9, line 2, page 9, line 29 to page 10, line 6, page 10, line 28 to page 11, line 7, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 14, 17; Fig. 4 – item 401), a mobile electronic device operable for wirelessly transmitting a request for promotional data and for wirelessly receiving generated promotion data (page 4, line 20 to page 5, line 2, page 5, line 27 to page 6, line 4, page 9, line 29 to page 10, line 17, page 10, line 28 to page 11, line 7, Fig. 1 – items 10, 11, 12; Fig. 2 – items 201 to 203; Fig. 3 – items 301, 302), and a database accessible by the processor and operable in conjunction with the processor for storing information used for generating the promotion (page 2, lines 20-29, page 5, lines 9-15, page 6, lines 5-14, page 8, line 9 to page 9, line 2, page 9, lines 9-15, page 9, line 29 to page 10, line 6, page 10, line 28 to page 11, line 20, page 11, line 28 to page 12, line 7, Fig. 1 – items 101, 13, 15; Fig. 3 – item 305; Fig. 4 – item 101).

According to independent claim 49, another embodiment of the claimed subject matter is a method for consumer contact comprising accessing a consumer database containing at least one profile of at least one consumer, transmitting, to a mobile electronic device of a consumer, data relating to a promotion, wherein the promotion is generated from the profile of the consumer (page 2, lines 20-29, page 5, lines 9-15, page 5, lines 22-26, page 5, line 27 to page 6, line 29, page 8, line 19 to page 9, line 2, page 9, lines 16-28, page 9, line 29 to page 10, line 6, page 10, line 28 to page 11, line 7, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 11, 13, 14; Fig. 3 – items 301, 302), and matching the promotion with a merchant profile in a merchant profile database when the consumer redeems the promotion by wirelessly communicating using the mobile electronic device in an electronic purchase (page 3, lines 1-4, page 7, lines 1-8, page 7, line 22 to page 8, line 8, page 9, lines 9-28, Fig. 1 – items 10, 11, 13, 15).

According to independent claim 55, another embodiment of the claimed subject matter is a mobile electronic device comprising means for requesting data regarding a promotion from a remote server (page 4, line 20 to page 5, line 2, page 5, line 27 to page 6, line 4, page 9, line 29 to page 10, line 17, page 10, line 28 to page 11, line 7, Fig. 1 – items 10, 11; Fig. 2 – item 201; Fig. 3 – item 301), means for receiving the data from the remote server (page 4, line 10 to page 5, line 2, page 5, line 27 to page 6, line 4, page 9, lines 3-28, page 10, lines 7-20, page 10, line 28 to page 11, line 7, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 11, 12; Fig. 2 – item 202; Fig. 3 – item 302; Fig. 4 – items 402, 403, 404), and means for applying received promotion data when a purchase is made at a point of sale (POS) (page 7, lines 1-9, page 7, line 22 to page 8, line 8, page 9, lines 9-28, Fig. 1 – items 10, 11, 13, 15).

According to dependent claim 58, a further embodiment of the claimed subject matter is the device of dependent claim 57 where the device is a mobile telephone and the unique identification is the telephone number (page 4, line 10 to page 5, line 8, page 7, line 22 to page 8, line 8, page 11, line 21 to page 12, line 7, page 11, line 28 to page 12, line 7, Fig. 1 – item 10; Fig. 3 – items 302, 303; Fig. 4 – item 402).

According to independent claim 61, another embodiment of the claimed subject matter is a system for redeeming promotions (page 7, lines 1-9, page 7, line 22 to page 8, line 8, page 9, lines 9-28, Fig. 1 – item 10). The system comprises means for identifying a redeemable promotion (page 7, lines 1-9, page 9, lines 9-28, page 11, lines 17-27), a wireless mobile electronic device associated with a particular consumer (page 2, lines 20-29, page 4, lines 10-19, page 5, lines 3-8, Fig. 1 – item 11), and means for receiving from the wireless mobile electronic device associated with the particular consumer an acceptance of the promotion (page 10, line 21 to page 11, line 7, page 11, lines 21-27, Fig. 2 – item 208; Fig. 3 – item 308).

According to dependent claim 63, a further embodiment of the claimed subject matter is the system of dependent claim 62 further comprising means operable in response to communications from the wireless mobile electronic device for coordinating payment for the associated transaction (page 7, line 1 to page 8, line 8, Fig. 1 – items 10, 11, 18).



According to independent claim 66, another embodiment of the claimed subject matter is a system for coordinating transactions. The system comprises a server for accepting over a temporarily established communication connection from anyone from a plurality of users information specific to one of many merchants, the information including data specific to a unique POS location of one of the merchants (page 5, lines 9-15, page 5, lines 22-26, page 6, lines 5-29, Fig. 1 – items 10, 101, 104). The system also comprises means for coordinating the received information from a wireless mobile electronic data of a specific one of the users with information available to the server pertaining to the unique merchant location (page 5, line 9 to page 6, line 4, page 6, lines 15-29, Fig. 1 – items 10, 11, 14, 16, 17). The system further comprises means for communicating at least a portion of the coordinated information to the wireless mobile electronic device of the one user over the temporarily established connection, the coordinated information including promotional information associated with the specific user (page 6, lines 5-29, page 8, line 19 to page 9, line 2, page 9, lines 16-28, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 11, 14, 16, 17; Fig. 4 – items 403, 404), and means for coordinating the redemption of the promotion associated with the promotional information (page 7, line 1 to page 8, line 8, Fig. 1 – items 10, 18).

According to dependent claim 68, a further embodiment of the claimed subject matter is the system of dependent claim 67 further comprising means at the server for accepting further information from the wireless mobile electronic device of the one user, the further information comprising acceptance information for both the cost information and the promotion information (page 10, line 21 to page 11, line 7, page 11, lines 21-27, Fig. 2 – item 208; Fig. 3 – item 308).

According to dependent claim 69, a further embodiment of the claimed subject matter is the system of dependent claim 68 further comprising means at the server for coordinating payment to the one merchant from the one user (page 5, lines 22-26, page 7, lines 1-21, Fig. 1 – items 10, 18) the payment based upon the information communicated to the wireless mobile electronic device of the user and the acceptance information from the wireless mobile electronic device of the user (page 10, line 21 to page 11, line 7, page 11, lines 21-27, Fig. 2 – item 208, Fig. 3 – item 308).

According to independent claim 70, another embodiment of the claimed subject matter is a method for coordinating transactions. The method comprises accepting over a temporarily established wireless communication connection from a wireless mobile electronic device of any one of a plurality of users information specific to one of many merchants, the information including data specific to a unique location of one of the merchants, the specific data pertaining to merchandise obtained from the merchant (page 5, lines 9-15, page 5, lines 22-26, page 6, lines 5-29, Fig. 1 – items 10, 11, 15, 16). The method further comprises coordinating the received information from the wireless mobile electronic device specific one of the users with available information pertaining to the unique merchant location (page 5, line 9 to page 6, line 4, page 6, lines 15-29, Fig. 1 – items 10, 11, 15, 16), and communicating at least a portion of the coordinated information to the wireless mobile electronic device of the one user over the temporarily established wireless communication connection, the coordinated information including promotions available to the specific one of the users pertaining to the obtained merchandise (page 6, lines 5-29, page 8, line 19 to page 9, line 2, page 9, lines 16-28, page 11, line 28 to page 12, line 7, Fig. 1 – items 10, 11, 17; Fig. 4 – items 402, 403, 404).

According to dependent claim 72, a further embodiment of the claimed subject matter is the method of dependent claim 71 further comprising accepting further information from the wireless mobile electronic device of the one user, the further information comprising acceptance information for the cost information and for the promotion (page 10, line 21 to page 11, line 7, page 11, lines 21-27, Fig. 2 – item 208; Fig. 3 – item 308).

According to dependent claim 73, a further embodiment of the claimed subject matter is the method of dependent claim 72 further comprising coordinating payment to the one merchant from the one user (page 5, lines 22-26, page 7, lines 1-21, Fig. 1 – items 10, 18), the payment based upon the information communicated to the wireless mobile electronic device of the user and the acceptance information from the wireless mobile electronic device of the user, including acceptance or rejection of the promotion (page 4, line 20 to page 5, line 2, page 7, line 1 to page 8, line 8, page 10, line 21 to page 11, line 7, page 11, lines 21-27, Fig. 1 – items 10, 11 18; Fig. 2 – item 208; Fig. 3 – item 308).

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 66-69 are properly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

B. Whether claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63, and 65-73 are properly rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,237,145 to *Narasimhan* (hereinafter *Narasimhan*) in view of Official Notice and/or legal precedent.

## VII. ARGUMENT

Appellant respectfully traverses the outstanding rejections of the pending claims, and requests that the Board reverse the rejections in light of the remarks contained herein. The claims do not stand or fall together. Instead, Appellant presents separate arguments for various independent and dependent claims. Each of these arguments are separated below and presented with separate headings and sub-heading as required by 37 C.F.R. § 41.37(c)(1)(vii).

### A. First Ground of Rejection: 35 U.S.C. § 101 Rejection

Claims 66-69 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Examiner alleges that the claims are directed to non-statutory subject matter as they deal with “a system for redeeming promotions comprising a server and means for conducting the method steps” and a server and the means can be software. Office Action dated May 29, 2009 at 2. Applicant maintains that it unclear why the Examiner contends that the recited server and/or means are software per se. However, in order to advance prosecution, Applicant proposed amendments to claims 66, 68 and 69 to recite that the means steps are performed in software stored on a tangible computer readable storage medium. More specifically, Applicant amended claim 66 to include the limitation “wherein said means for coordinating said received information, said means for communicating and said means for coordinating the redemption are performed in software stored on a tangible computer readable storage medium.” Claim 68 was amended to recite “wherein said means for accepting are performed in software stored on a tangible computer readable storage medium.” Applicant amended claim 69 to recite “wherein said means for coordinating payment are performed in software stored on a tangible computer readable storage medium.”

These amendments constituted the only amendments made in response to the Office Action dated May 29, 2009, and the amendments were made in direct response to the Examiner's comments. More specifically, the Examiner noted in the Office Action that Applicant had not narrowed down the claims to read only on a statutory embodiment and indicated that Applicant should clarify whether the software was stored on a tangible computer readable storage medium. In response to the Examiner's comments, Applicant made the above-referenced amendments. However, in the Advisory Action mailed August 11, 2009, the Examiner refused to enter the amendments, alleging that there was insufficient support for the claims as amended and further consideration was needed. Applicant respectfully disagrees and also challenges the Examiner's assertions, particularly insofar as this issue had not been previously raised in the prior office actions, and the Examiner implicitly requested these amendments be made. Applicant maintains that these amendments are properly supported by the specification (*see, e.g.*, page 3, lines 5-11, page 4, lines 10-19, page 4, line 20 to page 5, line 2, page 5, lines 22-26, page 6, lines 5-14, page 8, lines 9-18, and page 9, lines 9-15 of Applicant's specification) and were prompted by the Examiner's continued rejection of these claims under 35 U.S.C. § 101. Further, the Examiner even acknowledged that the claims could read on both software per se and software on a tangible computer readable storage medium. Office Action mailed May 29, 2009 at 3. As such, the Examiner admitted that the amendments made by Applicant are proper to narrow the claim to read on an alleged statutory embodiment. Therefore, Applicant contends that the claims address the Examiner's rejection, and accordingly, Applicant respectfully requests that the amendments be entered and the rejection under 35 U.S.C. § 101 be withdrawn.

**B. Second Ground of Rejection: 35 U.S.C. § 103 Rejection over *Narasimhan* in view of Official Notice and/or legal precedent**

Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63, and 65-73 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Narasimhan* in view of Official Notice and/or legal precedent.

The United States Patent and Trademark Office (PTO) bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. § 2142; *In re Peehs*, 612 F.2d 1287, 204 USPQ 835, 837 (CCPA 1980). In an obviousness rejection, "[u]nder § 103, the scope and content of the prior art are to be determined; differences

between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” *Graham v. John Deere Co.*, 383 U.S. 1, 15 - 17 (1966). Where the differences between the claims and the applied art set the claims apart from the applied art the claims are patentable. *See United States v. Adams* 383 U.S. 39, 48 (holding that the Government erred in concluding that wet batteries are old in the art because, among other things, “the fact that the Adams battery is water-activated sets his device apart from the prior art.”). The patentability of the rejected claims is discussed below.

As a preliminary matter, Applicant notes that the rejections set forth in the Office Action mailed on May 29, 2009 with respect to *Narasimhan* reference the December 7, 2007 Office Action. *See, e.g.*, Office Action of May 29, 2009 at 6. However, neither the October 15, 2008 nor the May 29, 2009 Office Actions address Applicant’s arguments made in response to the December 7, 2007 Office Action, the revised comments made by the Examiner in the April 22, 2008 or the interview summary mailed July 2, 2008. “Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” *See* M.P.E.P. § 707.07(f). Applicant therefore respectfully requests that the Examiner be required to reconsider Applicant’s previous arguments with respect to the *Narasimhan* reference.

Moreover, Applicant notes that the Response to Arguments contained in the May 29, 2009 Office Action failed to address the substance of all of Applicant’s arguments traversing the prior rejections. Again, “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” *See* M.P.E.P. § 707.07(f). Applicant therefore respectfully requests that the Examiner be required to reconsider Applicant’s arguments.

The Supreme Court stated that “[a] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). The Supreme Court also acknowledged the importance of identifying “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” in an obviousness determination. *Id.* at 1731. The Court indicated that there should be an “explicit” analysis regarding “whether there was an *apparent reason* to

combine the known elements *in the fashion claimed* by the patent at issue.” *Id.* (emphasis added). Further, the Court did not reject the use of the “teaching, suggestion, or motivation” test as a factor in the obviousness analysis, but rather stated that this test may be indicative of non-obviousness under 35 U.S.C. § 103. *Id.* When determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I).

### 1. Independent Claim 1 and Related Dependent Claims

Independent claim 1 recites a method for distributing promotions comprising, in part, “wirelessly transmitting data relating to said promotion to a mobile electronic device of said specific consumer.” Applicant maintains that the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 1 as it is not capable of wirelessly transmitting or receiving data through a network. The Examiner stated that “Applicants seem to repeat the argument that the smart card of *Narasimhan* is not a wireless device.” Office Action of May 29, 2009 at 29. However, as noted above, Applicant maintains that the smart card of *Narasimhan* is not capable of wirelessly transmitting or receiving data through a network, and the Examiner has not refuted this assertion.

The Examiner further states that “[i]t appears Applicant argues *Narasimhan*’s portable card device . . . with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*.” Office Action of May 29, 2009 at 7. The Examiner failed to challenge the statements in *Narasimhan* that the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user’s computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Examiner asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner

Myhre. Office Action of May 29, 2009 at 7. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. The Examiner states that “[i]t is noted statements like ‘it is known before invention time’ are equivalents to Official Notice. It is noted several references were provided in support of such statements.” Office Action of May 29, 2009 at 29. Applicant respectfully disagrees with this characterization of Examiner Myhre’s statements. The Examiner merely references the December 7, 2007 Office Action as containing statements allegedly constituting Official Notice. However, a review of that Office Action reveals that Examiner Myhre only relied upon *Narasimhan* for the rejections made under 35 U.S.C. § 102 and 35 U.S.C. § 103. No other references were provided in support of such statements made by the Examiner. As such, Applicant contends that the Examiner has failed to demonstrate that there are any such Officially Noticed facts allegedly taken by Examiner Myhre.

Applicant contends that Examiner Myhre never took Official Notice during the prosecution of the present application. Applicant does not find statements such as “it is known before invention time” in Examiner Myhre’s rejections, and Examiner Myhre did not rely upon any references other than *Narasimhan* in making his rejections, contrary to the present Examiner’s allegations. *See, e.g.*, Advisory Action mailed August 11, 2009. The present Examiner failed to identify any Official Notice taken by Examiner Myhre in the Office Actions mailed December 7, 2007 and April 22, 2008, the Examiner Interview or the Advisory Action mailed July 2, 2008. Prosecution of the present application was turned over to the present Examiner upon filing of the Request for Continued Examination on July 22, 2008. *See id.* Applicant therefore is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the present examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. As such, Applicant respectfully requests that any rejections made with respect to Examiner Myhre’s alleged Official Notice be withdrawn.

Further, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 1. The references cited in the Office Action of May 29, 2009 do not demonstrate the

interchangeability of the *Narasimhan* smart card with other user devices. The Examiner states that “[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data” and cites several patents as allegedly supporting this assertion. Office Action of May 29, 2009 at 7-8. However, the cited patents fail to teach at least “wirelessly transmitting data relating to said promotion to a mobile electronic device of said specific consumer” as recited in claim 1. For example, *Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Examiner suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. *See, e.g.*, column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Examiner implies. In any event, there is no teaching in *Kolls* of a smart card and a smart card reader/writer being interchangeable with a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in the art so as to allegedly support the Examiner’s reasoning related to *Narasimhan* or the alleged Official Noticed facts, and the Examiner failed to respond to Applicant’s assertions regarding *Kolls*.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. *See, e.g.*, column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. *See, e.g.*, column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device or wirelessly applying a promotion to a purchase using a mobile electronic device. The Examiner failed to address Applicant’s statements regarding *Freeman* in the Office Action of May 29, 2009.

In addition, the Examiner’s reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited in the Office Action of May 29, 2009 describes later downloading coupons in a portable device but does not equate a smart card of the type set



forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims. The Examiner asserts that *Aggarwal* allegedly shows "the interchangeability of the several mobile devices to transfer promotion-related data, including using cellphones which clearly are wireless devices." See Office Action of May 29, 2009 at 29. Applicant respectfully maintains that it would not have been obvious to substitute different cell phone devices as disclosed in *Aggarwal* with the smart card of the type set forth in *Narasimhan*, and the Examiner has not provided support to the contrary. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*.

The Examiner has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant maintains that *Leapfrog v. Fisher-Price* is not applicable. The Examiner has failed to show that the references allegedly provide support for the reasoning set forth by the Examiner or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Examiner has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with "modern components" or how the "modern components" allegedly teach what is claimed by Applicant. While the smart card may be carried around by the user, there is no teaching set forth in the reference for incorporating the *Narasimhan* smart card into other mobile devices or updating the smart card with "modern components." As the references cited by the Examiner do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the "unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by Freeman or with a portable phone as taught in *Aggarwal*" as the Examiner suggests. See Office Action of May 29, 2009 at 11-12.

Further, while the Examiner alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.,* Office Action of May 29, 2009 at 7-12), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has

not discharged the burden of showing *prima facie* obviousness. Thus, claim 1 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action of May 29, 2009 at 9. Further, the Examiner contends that *Aggarwal* is “clear evidence of the Examiner’s assertion of the ‘trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.’” *See* Office Action of May 29, 2009 at 29. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*. As such, Applicant respectfully requests that this rejection be withdrawn.

Further, independent claim 1 recites, in part, “wirelessly applying said promotion to a purchase using said mobile electronic device.” *Narasimhan* fails to teach or suggest this limitation. The Examiner alleges that the smart card is performing the functions of the claimed “mobile electronic device.” *See* Office Action of May 29, 2009 at 12-13. The Examiner further suggests that “the promotion data (coupons) is being transmitted (and stored) onto the smart card and the merchant device is receiving a response from the smart card when querying the clipped coupon database to retrieve the promotion information (coupon).” *Id.* Again, the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 1 as the smart card must be ***physically connected*** to the merchant device through a smart card reader/writer to allow the merchant device to read the coupons on the smart card. *See, e.g.*, column 7, lines 27-31. As such, a physical connection is required to apply a promotion to a purchase using the smart card of *Narasimhan* and a promotion is not being wirelessly applied using a mobile electronic device. The merchant does not read the clipped electronic coupons from a mobile electronic device in *Narasimhan* but rather reads the coupons stored on the database by use of a smart card reader/writer. The Examiner also alleges that “[o]ne would have been motivated to incorporate the functionality and storage of the smart card into other mobile devices, such a cell phone, in order to eliminate the need to carry multiple mobile devices (e.g. a smart card, a cell phone, AND a pager). *See* Office Action of May 29, 2009 at 13. Again, while the smart card of *Narasimhan* may be carried around by the user, there is no teaching or suggestion set forth in the reference for

incorporation of the smart card taught in *Narasimhan* into other mobile devices as discussed above, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, *Narasimhan* does not teach or suggest this limitation of claim 1.

Claims 2-5 and 7-12 depend directly or indirectly from base claim 1 and thus inherit all limitations of base claim 1. However, each of these claims set forth features and limitations not recited by the references. Thus, Applicant respectfully asserts that for the above reasons, claims 2-5 and 7-12 are patentable over the rejections of record.

## **2. Dependent Claim 3**

Claim 3 recites “receiving a response from said mobile electronic device of said specific consumer, wherein said response is received wirelessly.” *Narasimhan* does not teach or suggest this limitation as the smart card does not provide a response and any communication that the smart card user has occurs via action by the merchant device or the user’s personal computer, not the smart card. *See, e.g.*, column 6, lines 30-36 and 52-57; column 7, lines 27-37. Even assuming *arguendo* that the smart card provides a response, it does not do so without being swiped through or inserted into a card reader connected to the merchant device which reads clipped electronic coupons stored on the smart card. *See, e.g.*, column 7, lines 27-31. Thus, any response received from the smart card of *Narasimhan* is not received wirelessly.

## **3. Dependent Claims 7 and 8**

Claim 7 recites that “said transmitted data is a text message” and claim 8 recites that “said transmitted data is a voice mail message.” Claims 7 and 8 are not taught or suggested by *Narasimhan* as text messages or voice mail messages are not transmitted from a smart card. These messages are now known to be wirelessly transmitted, and data is not pulled from the smart card of *Narasimhan* other than by swiping or inserting the smart card through a card reader. Moreover, the electronic coupon itself is read from the smart card, and thus, no data is transmitted from the smart card in the form of a text message or voice mail message.

#### 4. Independent Claim 13 and Related Dependent Claims

Independent claim 13 recites, in part, “a method of wirelessly receiving and redeeming promotions via a mobile electronic device.” *Narasimhan* does not teach or suggest this limitation. A user of the smart card disclosed in *Narasimhan* does not wirelessly receive or redeem promotions via the smart card. Rather, the user clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by employing a smart card reader/writer. *See, e.g.*, column 7, lines 23-27. Further, the user redeems a coupon stored on the smart card by swiping or inserting the smart card through a smart card reader/writer attached to the merchant device. *See, e.g.*, column 6, lines 52-55; column 7, lines 27-31. The smart card therefore is tethered to the reader/writer in order for promotions to be read from or stored onto the smart card. The Examiner alleges that “the smart card replies to an inquiry from the merchant device by retrieving (accessing) the promotion (coupon) data from the database when redeeming the promotion and transmitting (replying) the data to the merchant device.” *See* Office Action of May 29, 2009 at 17. Applicant respectfully disagrees that this assertion indicates that the limitations of claim 13 have been met. Rather, as previously discussed, the user clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by employing a smart card reader/writer. *See, e.g.*, column 7, lines 23-27. The smart card reader/writer later retrieves the coupon from the smart card, and thus, the smart card does not behave as a mobile electronic device to receive and redeem promotions in accordance with claim 13. Thus, independent claim 13 should be deemed patentable over the rejection of record.

Further, claim 13 recites, in part, “accessing, with said mobile electronic device, data, relating to said promotion, wirelessly transmitted to said mobile electronic device from a server.” *Narasimhan* fails to teach or suggest this limitation. Again, no data relating to a promotion is wirelessly transmitted to the smart card from a server. Rather, the user clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by inserting or swiping the smart card into a smart card reader/writer. *See, e.g.*, column 7, lines 23-27. Accordingly, the user’s personal computer receives the data from the server, not the smart card. As such, claim 13 is patentable over the rejection of record.

Independent claim 13 also recites, in part, “redeeming said promotion by wirelessly replying to said server using said mobile electronic device.” *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* does not include any mechanism (i.e., input means or the like) to allow a user of a smart card to wirelessly reply to a server using the smart card. Rather, the smart card is swiped or inserted into a smart card reader/writer so as to permit a promotion to be redeemed, and it is the merchant device or the user’s personal computer, depending on the stage when the promotion is to be redeemed, and not the smart card, that communicates with the server to redeem a promotion. *See, e.g.*, column 6, lines 52-57; column 7, lines 27-31. Moreover, the Examiner (*see* Office Action of May 29, 2009 at 16-17) failed to demonstrate how *Narasimhan* and *Aggarwal* allegedly may be combined so as to set forth a *prima facie* case of obviousness. Thus, claim 13 is patentable over the rejection of record.

Claims 14 and 16-21 depend directly or indirectly from base claim 13 and thus inherit all limitations of base claim 13. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 14 and 16-21 are patentable over the rejection of record.

## **5. Dependent Claim 16**

Claim 16 recites that “said consumer wirelessly requests said promotion from said server by using said mobile electronic device.” *Narasimhan* fails to teach or suggest this limitation because the smart card does not include any mechanism (i.e., input means or the like) to allow a user of a smart card to wirelessly request a promotion from a server. Rather, any communication that the user of the smart card has with a server occurs via action by the merchant device or the user’s personal computer, not the smart card. *See, e.g.*, column 6, lines 30-36 and 52-57; column 7, lines 27-31. The Examiner alleges that *Narasimhan* teaches this limitation as it allegedly “discloses a promotion distributor generating the promotion based on a request from the consumer.” Office Action of May 29, 2009 at 25. However, the cited passages from *Narasimhan* merely teach that the user browses promotions on his/her personal computer (column 3, lines 10-16) and do not teach that a consumer wirelessly requests a promotion from the server by using a mobile electronic device.

**6. Dependent Claim 21**

Further, claim 21 recites “wherein said redeeming is by telephone, text message, or multi-media message.” *Narasimhan* fails to teach or suggest this limitation. While the Examiner is correct that promotional information set forth in *Narasimhan* may be textual, graphic, video or audio information (*see* Office Action of May 29, 2009 at 25 referencing column 3, lines 28-35 of *Narasimhan*), nowhere does *Narasimhan* teach or suggest that a promotion may be redeemed by telephone, text message or multi-media message. Text messages or voice mail messages are not transmitted from a smart card. These messages are now known to be wirelessly transmitted, and data is not pulled from the smart card of *Narasimhan* other than by swiping or inserting the smart card through a card reader. Moreover, the electronic coupon itself is read from the smart card, and thus, no data is transmitted from the smart card in the form of a text message or voice mail message.

**7. Independent Claim 22**

Independent claim 22 recites a method for distributing a promotion comprising, in part, “sending promotion data to a consumer web portal account wirelessly accessible on a mobile electronic device of said consumer.” *Narasimhan* fails to teach or suggest this limitation. Promotion data is not wirelessly accessible on the smart card of *Narasimhan*. Rather, the smart card must be physically associated with a smart card reader/writer in order for promotion data to be stored on or retrieved from the smart card. *See, e.g.*, column 7, lines 23-27. Moreover, *Narasimhan* does not teach or suggest that a consumer web portal account is wirelessly accessible on a smart card. Even assuming *arguendo* that a consumer web portal account is disclosed in *Narasimhan*, it is the user’s personal computer that accesses a server containing a web portal account, not the smart card. *See, e.g.*, column 4, lines 9-20. Thus, claim 22 should be deemed patentable over the rejection of record.

Further, independent claim 22 recites, in part, “saving said promotion in a promotion saving account accessible by said mobile electronic device wherein said consumer wirelessly redeems said promotion using said mobile electronic device for a purchase at a point of sale (POS).” *Narasimhan* fails to teach or suggest this limitation. Again, the smart card of *Narasimhan* does not meet the limitations of a mobile electronic device as set forth in claim

22 as the smart card must be physically connected to the merchant device through a smart card reader/writer to allow the merchant device to read the coupons on the smart card. *See, e.g.*, column 7, lines 27-31. A user of the smart card disclosed in *Narasimhan* swipes or inserts the smart card through a smart card reader/writer connected to the merchant device so that the merchant device may access the coupons stored on the smart card. The merchant device then redeems the promotion. *See, e.g.*, column 7, lines 27-31. The Examiner appears to assert that a database in *Narasimhan* “would inherently be accessible by the smart card when redeeming the coupon at the merchant device.” *See* Office Action of May 29, 2009 at 19. However, this inherency argument provides no justification for the assertion that this claim limitation is allegedly taught by *Narasimhan*, as the Examiner is required to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. M.P.E.P. § 2112. Moreover, the Examiner appears to rely on a combination of *Narasimhan* and *Aggarwal* to allege that this limitation has been met (*see* Office Action of May 29, 2009 at 19); however, the Examiner does not indicate how these references may be combined and does not show an apparent reason to combine the elements in the fashion claimed in claim 22. As such, the Examiner has not discharged his burden of making a *prima facie* case of obviousness with respect to claim 22.

#### 8. Independent Claim 26 and Related Dependent Claims

Independent claim 26 recites, in part, “a method for wirelessly distributing a promotion to a mobile electronic device of a targeted consumer.” *Narasimhan* does not teach or suggest this limitation. A promotion is not wirelessly distributed to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by *physically* associating the smart card with a smart card reader/writer attached to the personal computer. *See, e.g.*, column 7, lines 23-27. Thus, the promotion is not being wirelessly distributed to the smart card. As such, this limitation of claim 26 has not been met.

Claim 26 further recites “wirelessly transmitting data relating to said promotion to said mobile electronic device of said targeted consumer.” *Narasimhan* does not teach or suggest this limitation. Applicant maintains that the smart card of *Narasimhan* is not a

mobile electronic device as set forth in claim 26 as it is not capable of wirelessly transmitting or receiving data through a network. The Examiner states that “Applicants seem to repeat the argument that the smart card of *Narasimhan* is not a wireless device.” Office Action of May 29, 2009 at 29. However, as noted above, Applicant maintains that the smart card of *Narasimhan* is not capable of wirelessly transmitting or receiving data through a network, and the Examiner has not refuted this assertion. The Examiner further states that “[i]t appears Applicant argues *Narasimhan*’s portable card device . . . with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*.” Office Action of May 29, 2009 at 7. The Examiner failed to challenge the statements in *Narasimhan* that the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user’s computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Examiner asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre. Office Action of May 29, 2009 at 7. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. The Examiner states that “[i]t is noted statements like ‘it is known before invention time’ are equivalents to Official Notice. It is noted several references were provided in support of such statements.” Office Action of May 29, 2009 at 29. Applicant respectfully disagrees with this characterization of Examiner Myhre’s statements. The Examiner merely references the December 7, 2007 Office Action as containing statements allegedly constituting Official Notice. However, a review of that Office Action reveals that Examiner Myhre only relied upon *Narasimhan* for the rejections made under 35 U.S.C. § 102 and 35 U.S.C. § 103. No other references were provided in support of such statements made by the Examiner, and the Examiner has failed to provide any clarification as to the alleged support such Officially Noticed facts allegedly taken by Examiner Myhre.



Applicant contends that Examiner Myhre never took Official Notice during the prosecution of the present application. Applicant does not find statements such as “it is known before invention time” in Examiner Myhre’s rejections, and Examiner Myhre did not rely upon any references other than *Narasimhan* in making his rejections, contrary to the present Examiner’s allegations. *See, e.g.*, Advisory Action mailed August 11, 2009. The present Examiner failed to identify any Official Notice taken by Examiner Myhre in the Office Actions mailed December 7, 2007 and April 22, 2008, the Examiner Interview or the Advisory Action mailed July 2, 2008. Prosecution of the present application was turned over to the present Examiner upon filing of the Request for Continued Examination on July 22, 2008. *See id.* Applicant therefore is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the present examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. As such, Applicant respectfully requests that any rejections made with respect to Examiner Myhre’s alleged Official Notice be withdrawn.

In any event, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 26. The Examiner states that “[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data” and cites several patents as allegedly supporting this assertion. Office Action of May 29, 2009 at 7. However, the cited patents fail to teach at least “wirelessly transmitting data relating to said promotion to a mobile electronic device of said targeted consumer” as recited in claim 26. For example, *Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Examiner suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. *See, e.g.*, column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Examiner implies. In any event, there is no teaching in *Kolls* of a smart card and a smart card reader/writer being interchangeable with a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in the art so as to allegedly support the Examiner’s reasoning related to *Narasimhan* or the

alleged Official Noticed facts, and the Examiner failed to respond to Applicant's assertions regarding *Kolls*.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. *See, e.g.*, column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. *See, e.g.*, column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device or wirelessly applying a promotion to a purchase using a mobile electronic device. The Examiner failed to address Applicant's statements regarding *Freeman* in the Office Action of May 29, 2009.

In addition, the Examiner's reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited by the Examiner describes later downloading coupons in a portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims. The Examiner asserts that *Aggarwal* allegedly shows "the interchangeability of the several mobile devices to transfer promotion-related data, including using cellphones which clearly are wireless devices." *See* Office Action of May 29, 2009 at 29. Applicant respectfully maintains that it would not have been obvious to substitute different cell phone devices as disclosed in *Aggarwal* with the smart card of the type set forth in *Narasimhan*, and the Examiner has not provided support to the contrary. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*.

The Examiner has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant maintains that *Leapfrog v. Fisher-Price* is not applicable. The Examiner has failed to show that the references allegedly provide support for the reasoning set forth by

the Examiner or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Examiner has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with “modern components” or how the “modern components” allegedly teach what is claimed by Applicant. While the smart card may be carried around by the user, there is no teaching set forth in the reference for incorporating the *Narasimhan* smart card into other mobile devices or updating the smart card with “modern components.” As the references cited by the Examiner do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the “unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by Freeman or with a portable phone as taught in Aggarwal” as the Examiner suggests. *See* Office Action of May 29, 2009 at 11-12.

Further, while the Examiner alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.*, Office Action of May 29, 2009 at 7-12), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 26 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action of May 29, 2009 at 9. Further, the Examiner contends that *Aggarwal* is “clear evidence of the Examiner’s assertion of the ‘trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.’” *See* Office Action of May 29, 2009 at 29. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*. As such, Applicant respectfully requests that this rejection be withdrawn.

Further, data relating to a promotion is not wirelessly transmitted to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by physically associating the smart

card with a smart card reader/writer attached to the personal computer. *See, e.g.*, column 7, lines 23-27. Thus, a physical connection is needed between the smart card reader/writer and the smart card, and even so, the data is transmitted to the user's personal computer, not to the smart card. As such, claim 26 should be deemed patentable over the rejection of record.

The Examiner also states that Applicant has argued that the step of "generating said promotion for use by a targeted consumer, wherein said targeted consumer is selected from a plurality of potential consumers" is not disclosed. *See* Office Action of May 29, 2009 at 13. Applicant respectfully disagrees as Applicant did not previously present this argument with respect to *Narasimhan*. Rather, in the Amendment Accompanying Request for Continued Examination filed July 22, 2008, Applicant merely stated that the additional art referenced by the Examiner does not teach at least this step. *See* Amendment of July 22, 2008 at 14. Regardless, the Examiner has not shown that this step of claim 26 is taught by *Narasimhan*. Instead, the Examiner merely states that *Narasimhan* allegedly "discloses transmitting data relating to the promotion to a mobile electronic device." Office Action of May 29, 2009 at 13. However, *Narasimhan* does not transmit data relating to a promotion to a mobile electronic device as Applicant asserts that the smart card of *Narasimhan* is not a mobile electronic device. Further, as discussed above, claim 26 is directed to a method for wirelessly distributing a promotion to a mobile electronic device of a targeted consumer. Given that *Narasimhan* does not teach wirelessly distributing a promotion to a mobile electronic device of a targeted consumer or wirelessly transmitting data relating to said promotion to said mobile electronic device of said targeted consumer, it follows that *Narasimhan* cannot teach generating the promotion for use by such a targeted consumer.

Claims 27-29 depend directly or indirectly from base claim 26 and thus inherit all limitations of base claim 26. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 27-29 are patentable over the rejection of record.

#### **9. Independent Claim 30 and Related Dependent Claims**

Independent claim 30 recites, in part, "a method of wirelessly distributing a promotion to a mobile electronic device of a requesting consumer." *Narasimhan* does not teach or

suggest this limitation. A promotion is not wirelessly distributed to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by physically associating the smart card with a smart card reader/writer attached to the personal computer. *See, e.g.*, column 7, lines 23-27. Thus, the promotion is not being wirelessly distributed to the smart card. As such, this limitation of claim 30 has not been met.

Claim 30 further recites “wirelessly transmitting data relating to said promotion to said mobile electronic device of said requesting consumer.” *Narasimhan* does not teach or suggest this limitation. Applicant maintains that the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 30 as it is not capable of wirelessly transmitting or receiving data through a network. The Examiner further states that “Applicants seem to repeat the argument that the smart card of *Narasimhan* is not a wireless device.” Office Action of May 29, 2009 at 29. However, as noted above, Applicant maintains that the smart card of *Narasimhan* is not capable of wirelessly transmitting or receiving data through a network, and the Examiner has not refuted this assertion. The Examiner states that “[i]t appears Applicant argues *Narasimhan*’s portable card device . . . with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*.” Office Action of May 29, 2009 at 7. The Examiner failed to challenge the statements in *Narasimhan* that the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user’s computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Examiner asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre and Applicant is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. Office Action of May 29, 2009 at 7. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre. The Examiner states that “[i]t is noted statements like ‘it is known before invention time’ are equivalents to

Official Notice. It is noted several references were provided in support of such statements.” Office Action of May 29, 2009 at 29. Applicant respectfully disagrees with this characterization of Examiner Myhre’s statements. The Examiner merely references the December 7, 2007 Office Action as containing statements allegedly constituting Official Notice. However, a review of that Office Action reveals that Examiner Myhre only relied upon *Narasimhan* for the rejections made under 35 U.S.C. § 102 and 35 U.S.C. § 103. No other references were provided in support of such statements made by the Examiner, and the Examiner has failed to provide any clarification as to the alleged support such Officially Noticed facts allegedly taken by Examiner Myhre.

Applicant contends that Examiner Myhre never took Official Notice during the prosecution of the present application. Applicant does not find statements such as “it is known before invention time” in Examiner Myhre’s rejections, and Examiner Myhre did not rely upon any references other than *Narasimhan* in making his rejections, contrary to the present Examiner’s allegations. *See, e.g.*, Advisory Action mailed August 11, 2009. The present Examiner failed to identify any Official Notice taken by Examiner Myhre in the Office Actions mailed December 7, 2007 and April 22, 2008, the Examiner Interview or the Advisory Action mailed July 2, 2008. Prosecution of the present application was turned over to the present Examiner upon filing of the Request for Continued Examination on July 22, 2008. *See id.* Applicant therefore is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the present examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. As such, Applicant respectfully requests that any rejections made with respect to Examiner Myhre’s alleged Official Notice be withdrawn.

Further, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 30. The Examiner states that “[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data” and cites several patents as allegedly supporting this assertion. Office Action of May 29, 2009 at 7-8. However, the cited patents fail to teach at least “wirelessly transmitting data relating to said promotion to a mobile electronic device of said specific consumer” as recited in claim 30. For example,

*Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Examiner suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. See, e.g., column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Examiner implies. In any event, there is no teaching in *Kolls* of a smart card and a smart card reader/writer being interchangeable with a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in the art so as to allegedly support the Examiner's reasoning related to *Narasimhan* or the alleged Official Noticed facts, and the Examiner failed to respond to Applicant's assertions regarding *Kolls*.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. See, e.g., column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. See, e.g., column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device. The Examiner failed to address Applicant's statements regarding *Freeman*.

In addition, the Examiner's reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited by the Examiner describes later downloading coupons in a portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims. The Examiner asserts that *Aggarwal* allegedly shows "the interchangeability of the several mobile devices to transfer promotion-related data, including using cellphones which clearly are wireless devices." See Office Action of May 29, 2009 at 29. Applicant respectfully maintains that it would not have been obvious to substitute different cell phone devices as disclosed in *Aggarwal* with the smart card of the type set forth in *Narasimhan*, and the Examiner has not provided support to the contrary. Regardless whether *Aggarwal* teaches the use of cellular

phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*.

The Examiner has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant maintains that *Leapfrog v. Fisher-Price* is not applicable. The Examiner has failed to show that the references allegedly provide support for the reasoning set forth by the Examiner or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Examiner has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with “modern components” or how the “modern components” allegedly teach what is claimed by Applicant. While the smart card may be carried around by the user, there is no teaching set forth in the reference for incorporating the *Narasimhan* smart card into other mobile devices or updating the smart card with “modern components.” As the references cited by the Examiner do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the “unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by Freeman or with a portable phone as taught in *Aggarwal*” as the Examiner suggests. *See* Office Action of May 29, 2009 at 11-12.

Further, while the Examiner alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.,* Office Action of May 29, 2009 at 7-12), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 30 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action of May 29, 2009 at 9. Further, the Examiner contends that *Aggarwal* is “clear evidence of the Examiner’s assertion of the ‘trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.’”



See Office Action of May 29, 2009 at 29. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*. As such, Applicant respectfully requests that this rejection be withdrawn.

Further, data relating to a promotion is not wirelessly transmitted to the smart card disclosed in *Narasimhan*. Rather, the user accesses the promotion via his/her personal computer, and the promotion is stored on the smart card by physically associating the smart card with a smart card reader/writer attached to the personal computer. See, e.g., column 7, lines 23-27. Thus, a physical connection is needed between the smart card reader/writer and the smart card, and even so, the data is transmitted to the user's personal computer, not to the smart card. As such, claim 30 should be deemed patentable over the rejection of record.

The Examiner also states that Applicant has previously argued that the step of "generating said promotion for use by a requesting consumer, wherein said requesting consumer is promoted to request said promotion" is not disclosed. See Office Action of May 29, 2009 at 13. Applicant respectfully disagrees as Applicant did not previously present this argument with respect to *Narasimhan*. Rather, in the Amendment Accompanying Request for Continued Examination filed July 22, 2008, Applicant merely stated that the additional art referenced by the Examiner does not teach at least this step. See Amendment of July 22, 2008 at 14. Regardless, the Examiner has not shown that this step of claim 30 is taught by *Narasimhan*. Instead, the Examiner merely states that *Narasimhan* allegedly "discloses transmitting data relating to the promotion to a mobile electronic device." Office Action of May 29, 2009 at 13. However, *Narasimhan* does not transmit data relating to a promotion to a mobile electronic device as Applicant asserts that the smart card of *Narasimhan* is not a mobile electronic device. Further, as discussed above, claim 30 is directed to a method for wirelessly distributing a promotion to a mobile electronic device of a requesting consumer. Given that *Narasimhan* does not teach wirelessly distributing a promotion to a mobile electronic device of a requesting consumer or wirelessly transmitting data relating to said promotion to said mobile electronic device of said requesting consumer, it follows that *Narasimhan* does not teach generating the promotion for use by the requesting consumer.

Claims 31-36 depend directly or indirectly from base claim 30 and thus inherit all limitations of base claim 30. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 31-36 are patentable over the rejection of record.

#### **10. Dependent Claim 33**

Claim 33 recites that “said requesting consumer contacts a distributor to request said promotion using said mobile electronic device.” *Narasimhan* does not teach or suggest this limitation as the user of a smart card does not contact a distributor to request a promotion using the smart card. Rather, the user communicates with the distributor, using, for example, his/her personal computer. When the promotion is later received, it is only then saved onto the smart card, and there are no input means on the smart card making it feasible to do so. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. The Examiner alleges that *Narasimhan* teaches this limitation as it allegedly “discloses a promotion distributor generating the promotion based on a request from the consumer.” Office Action of May 29, 2009 at 25. However, the cited passages from *Narasimhan* merely teach that the user browses promotions on his/her personal computer (column 3, lines 10-16) and does not teach that a consumer wirelessly requests a promotion from the server by using a mobile electronic device. Rather, the user generally communicates using his/her personal computer. When the promotion is received, it is only then saved onto the smart card, and there are no input means on the smart card. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. Further, *Narasimhan* discloses Internet or telephone interfaces to describe how the server may be connected to the user’s personal computer, *not* the form that the smart card may assume.

#### **11. Dependent Claim 35**

Dependent claim 35 recites that the requesting consumer contacts the distributor via his/her mobile electronic device by calling a telephone number, sending an email message, or sending a text message. A user cannot use the smart card of *Narasimhan* to contact the distributor by calling a phone number, sending an email message or sending a text message, and there are no input means on the smart card making it feasible to do so. Rather, the user generally communicates using his/her personal computer. When the promotion is received, it

is only then saved onto the smart card, and there are no input means on the smart card. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. Further, *Narasimhan* discloses Internet or telephone interfaces to describe how the server may be connected to the user's personal computer, *not* the form that the smart card may assume.

## 12. Independent Claim 37 and Related Dependent Claims

Independent claim 37 recites a method for distributing a promotional offer to a targeted consumer comprising, in part, “wirelessly transmitting said offer to a mobile electronic device of said targeted consumer, wherein said targeted consumer is selected from a plurality of potential consumers.” *Narasimhan* fails to teach or suggest this limitation. Specifically, an offer is not wirelessly transmitted to the smart card disclosed in *Narasimhan*. Rather, the offer is transmitted to the user's personal computer. Only when the electronic coupon associated with the offer is later received by the personal computer is the electronic coupon then saved onto the smart card. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. Thus, this limitation of claim 37 has not been met.

Applicant also maintains that the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 37 as it is not capable of wirelessly transmitting or receiving data through a network. The Examiner states that “Applicants seem to repeat the argument that the smart card of *Narasimhan* is not a wireless device.” Office Action of May 29, 2009 at 29. However, as noted above, Applicant maintains that the smart card of *Narasimhan* is not capable of wirelessly transmitting or receiving data through a network, and the Examiner has not refuted this assertion. The Examiner further states that “[i]t appears Applicant argues *Narasimhan*'s portable card device . . . with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*.” Office Action of May 29, 2009 at 7. The Examiner failed to challenge the statements in *Narasimhan* that the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user's computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Examiner asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre, and Applicant is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. Office Action of May 29, 2009 at 7. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre. The Examiner states that “[i]t is noted statements like ‘it is known before invention time’ are equivalents to Official Notice. It is noted several references were provided in support of such statements.” Office Action of May 29, 2009 at 29. Applicant respectfully disagrees with this characterization of Examiner Myhre’s statements. The Examiner merely references the December 7, 2007 Office Action as containing statements allegedly constituting Official Notice. However, a review of that Office Action reveals that Examiner Myhre only relied upon *Narasimhan* for the rejections made under 35 U.S.C. § 102 and 35 U.S.C. § 103. No other references were provided in support of such statements made by the Examiner, and the Examiner has failed to provide any clarification as to the alleged support such Officially Noticed facts allegedly taken by Examiner Myhre.

Applicant contends that Examiner Myhre never took Official Notice during the prosecution of the present application. Applicant does not find statements such as “it is known before invention time” in Examiner Myhre’s rejections, and Examiner Myhre did not rely upon any references other than *Narasimhan* in making his rejections, contrary to the present Examiner’s allegations. *See, e.g.*, Advisory Action mailed August 11, 2009. The present Examiner failed to identify any Official Notice taken by Examiner Myhre in the Office Actions mailed December 7, 2007 and April 22, 2008, the Examiner Interview or the Advisory Action mailed July 2, 2008. Prosecution of the present application was turned over to the present Examiner upon filing of the Request for Continued Examination on July 22, 2008. *See id.* Applicant therefore is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the present examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. As such, Applicant respectfully requests that any rejections made with respect to Examiner Myhre’s alleged Official Notice be withdrawn.

Further, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 37. The Examiner states that “[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data” and cites several patents as allegedly supporting this assertion. Office Action of May 29, 2009 at 7-8. However, the cited patents fail to teach at least “wirelessly transmitting said offer to a mobile electronic device of said targeted consumer” as recited in claim 37. For example, *Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Examiner suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. *See, e.g.*, column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Examiner implies. In any event, there is no teaching in *Kolls* of a smart card and a smart card reader/writer being interchangeable with a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in the art so as to allegedly support the Examiner’s reasoning related to *Narasimhan* or the alleged Official Noticed facts, and the Examiner failed to respond to Applicant’s assertions regarding *Kolls*.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. *See, e.g.*, column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. *See, e.g.*, column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device or wirelessly applying a promotion to a purchase using a mobile electronic device. The Examiner failed to address Applicant’s statements regarding *Freeman*.

In addition, the Examiner’s reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited by the Examiner describes later downloading coupons in a

portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims. The Examiner asserts that *Aggarwal* allegedly shows "the interchangeability of the several mobile devices to transfer promotion-related data, including using cellphones which clearly are wireless devices." See Office Action of May 29, 2009 at 29. Applicant respectfully maintains that it would not have been obvious to substitute different cell phone devices as disclosed in *Aggarwal* with the smart card of the type set forth in *Narasimhan*, and the Examiner has not provided support to the contrary. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*.

The Examiner has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant maintains that *Leapfrog v. Fisher-Price* is not applicable. The Examiner has failed to show that the references allegedly provide support for the reasoning set forth in the Office Action of May 29, 2009 or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Examiner has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with "modern components" or how the "modern components" allegedly teach what is claimed by Applicant. While the smart card may be carried around by the user, there is no teaching set forth in the reference for incorporating the *Narasimhan* smart card into other mobile devices or updating the smart card with "modern components." As the references cited by the Examiner do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the "unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by Freeman or with a portable phone as taught in *Aggarwal*" as the Examiner suggests. See Office Action of May 29, 2009 at 11-12.

Further, while the Examiner alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.,* Office Action of May 29, 2009 at 7-12), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of

the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 37 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action of May 29, 2009 at 9. Further, the Examiner contends that *Aggarwal* is “clear evidence of the Examiner’s assertion of the ‘trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.’” *See* Office Action of May 29, 2009 at 29. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*. As such, Applicant respectfully requests that this rejection be withdrawn.

Independent claim 37 further recites “receiving a reply from said mobile electronic device of said targeted consumer in response to said promotional offer.” *Narasimhan* also fails to teach or suggest this limitation. The smart card of *Narasimhan* does not reply to a promotional offer. Rather, the user considers the promotional offer by reviewing the offer on his/her personal computer. If the offer is later accepted, the user will receive an electronic coupon that is then saved onto the smart card. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. Accordingly, the user of the system set forth in *Narasimhan* makes a decision as to whether to reply to a promotional offer using his/her personal computer and not the smart card. Further, there are no input means provided on the smart card to permit a user to reply to an offer using said smart card. Accordingly, Applicant respectfully asserts that claim 37 is patentable over the rejection of record.

The Examiner further suggests that Applicant has previously argued that “facilitating a purchase by said targeted consumer, said purchase correlated to said promotional offer” is not disclosed by *Narasimhan*. *See* Office Action of May 29, 2009 at 11. Applicant respectfully disagrees as Applicant has previously presented this argument with respect to *Narasimhan*. Rather, in the Amendment Accompanying Request for Continued Examination filed July 22, 2008, Applicant merely stated that the additional art referenced by the Examiner does not teach at least this step. *See* Amendment of July 22, 2008 at 14.

Regardless, the Examiner has not discharged the burden of showing *prima facie* obviousness with respect to the combination of applied references.

Claims 38-40 depend directly or indirectly from base claim 37 and thus inherit all limitations of base claim 37. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 38-40 are patentable over the rejection of record.

### **13. Independent Claim 41 and Related Dependent Claims**

Independent claim 41 recites a system for distributing and redeeming a promotion comprising, in part, “a mobile electronic device operable for wirelessly transmitting a request for promotional data and for wirelessly receiving generated promotion data.” *Narasimhan* fails to teach or suggest this limitation. As previously discussed, the smart card of *Narasimhan* does not wirelessly transmit a request for promotional data or wirelessly receive generated promotion data. Rather, the user requests and reviews promotions presented on his/her personal computer (*see, e.g.*, column 3, lines 9-16). When the user wishes to take advantage of a promotion, he/she requests a coupon associated with the promotion (*see, e.g.*, column 6, lines 30-36) which may then be saved to the smart card which is physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Accordingly, the smart card of *Narasimhan* neither wirelessly transmits a request for promotional data nor does it wirelessly receive generated promotional data.

The Examiner further alleges that the smart card “has at least one input means and at least output means (in order to receive and send the promotional data to and from the database” and thus “it is inherently capable of transmitting the request through its output means and receiving the promotional data through its input means.” *See* Office Action of May 29, 2009 at 19-20. Applicant respectfully disagrees. The Examiner failed to identify the alleged input and output means of the smart card of *Narasimhan*. Rather, data is placed onto the smart card via a smart card reader/writer as discussed above. *See, e.g.*, column 7, lines 23-27. In order to properly establish a rejection based on inherency, “the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior



art.” M.P.E.P. § 2112, (citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis original)). The Examiner’s statement that the smart card is inherently capable of transmitting the request through its output means and receiving the promotional data through its input means does not reasonably support a conclusion that the smart card actually can transmit and receive requests necessarily flows from the disclosure of the prior art. As such, Applicant asserts that this limitation of claim 41 has not been met.

The Examiner appears to assert that a database in *Narasimhan* “would inherently be accessible by the smart card when redeeming the coupon at the merchant device.” *See* Office Action of May 29, 2009 at 19. However, this inherency argument provides no justification for the assertion that this claim limitation is allegedly taught by *Narasimhan*. Moreover, the Examiner appears to rely on a combination of *Narasimhan* and *Aggarwal* to allege that this limitation has been met (*see* Office Action of May 29, 2009 at 15); however, the Examiner does not indicate how these references may be combined and does not show an apparent reason to combine the elements in the fashion claimed in claim 41. As such, the Examiner has not discharged his burden of making a *prima facie* case of obviousness with respect to claim 41. Therefore, this limitation of claim 41 has not been met.

Claims 44-48 depend directly or indirectly from base claim 41 and thus inherit all limitations of base claim 41. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 44-48 are patentable over the rejection of record.

#### **14. Independent Claim 49 and Related Dependent Claims**

Independent claim 49 recites a method for consumer contact comprising, in part, “transmitting, to a mobile electronic device of a consumer, data relating to a promotion, wherein said promotion is generated from the profile of said consumer.” *Narasimhan* fails to teach or suggest this limitation. As previously discussed, data relating to a promotion is not transmitted to the smart card disclosed in *Narasimhan*. Rather, the user in *Narasimhan* reviews data relating to a promotion on his/her personal computer (*see, e.g.,* column 3, lines 9-16). When the user wishes to take advantage of a promotion, he/she requests a coupon associated with the promotion (*see, e.g.,* column 6, lines 30-36) and it is that coupon which

may be saved to the smart card which has been physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Thus, no data relating to a promotion is being transmitted to the smart card of *Narasimhan*. Accordingly, claim 49 should be deemed patentable over the rejection of record.

Claim 49 further recites “matching said promotion with a merchant profile in a merchant profile database when said consumer redeems said promotion by wirelessly communicating using said mobile electronic device in an electronic purchase.” *Narasimhan* fails to teach or suggest this limitation. A user does not redeem a promotion by wirelessly communicating using the smart card of *Narasimhan*. Rather, a user of the system set forth in *Narasimhan* redeems the promotion on his/her personal computer (*see, e.g.*, column 3, lines 9-16) by requesting a coupon associated with the promotion (*see, e.g.*, column 6, lines 30-36). That coupon is then saved to the smart card which has been physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Even assuming *arguendo* a promotion may be saved on the smart card, a promotion still is not wirelessly redeemed with the smart card. Rather, the smart card is again physically associated with a smart card reader/writer, and the promotion would be extracted and redeemed via actions of the smart card reader/writer and/or the merchant device, not the smart card. Thus, a user of the smart card disclosed in *Narasimhan* is not redeeming a promotion by wirelessly communicating using the smart card in an electronic purchase. Accordingly, this limitation of claim 49 has not been met.

While the Examiner acknowledges that the Applicant has previously argued that at least this limitation of claim 49 has not been met, the Examiner has failed to acknowledge Applicant’s arguments. *See* Office Action of May 29, 2009 at 20-22. Specifically, the Examiner ignores Applicant’s arguments concerning the portion of the claim limitation “when said consumer redeems said promotion by wirelessly communicating using said mobile electronic device in an electronic purchase.” Moreover, while the Examiner refers to a combination of *Narasimhan* and *Aggarwal* as allegedly teaching this limitation at claim 49 (*see* Office Action of May 29, 2009 at 21), the Examiner failed to assert where in *Aggarwal* this claim limitation is allegedly taught as it is not taught by *Narasimhan*. Thus, a *prima facie* case of obviousness with respect to the combination of applied references has not been established.

Claims 50 and 52-54 depend directly or indirectly from base claim 49 and thus inherit all limitations of base claim 49. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 50 and 52-54 are patentable over the rejection of record.

#### **15. Independent Claim 55 and Related Dependent Claims**

Independent claim 55 is directed to a mobile electronic device comprising, in part, “means for requesting data regarding a promotion from a remote server” and “means for receiving said data from said remote server.” Applicant respectfully asserts that *Narasimhan* fails to teach these limitations. The Examiner acknowledges that the user in *Narasimhan* “requests the promotional data by logging in and walking through the hierarchical tree to select the desired promotional data (coupons) which are then stored in the database on the smart card.” Accordingly, the user uses his/her personal computer to request data regarding a promotion from a remote server and does not use the smart card to make such a request. *See, e.g.*, column 3, lines 9-16; column 6, lines 30-36. The server sends a coupon to the user’s personal computer, and the user saves that coupon to the smart card which has been physically associated with the personal computer via a smart card reader/writer (*see, e.g.*, column 7, lines 23-27). Accordingly, the smart card of *Narasimhan* does not receive data regarding a promotion from a remote server; rather, the smart card receives a coupon from the user’s personal computer. Thus, these limitations of claim 55 have not been met.

Applicant again maintains that the smart card of *Narasimhan* is not a mobile electronic device as set forth in claim 55 as it is not capable of wirelessly transmitting or receiving data through a network. The Examiner states that “Applicants seem to repeat the argument that the smart card of *Narasimhan* is not a wireless device.” Office Action of May 29, 2009 at 29. However, as noted above, Applicant maintains that the smart card of *Narasimhan* is not capable of wirelessly transmitting or receiving data through a network, and the Examiner has not refuted this assertion. The Examiner further states that “[i]t appears Applicant argues *Narasimhan*’s portable card device . . . with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*.” Office Action of May 29, 2009 at 7. The Examiner failed to

challenge the statements in *Narasimhan* that the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user's computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Examiner asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre. Office Action of May 29, 2009 at 7. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. The Examiner states that “[i]t is noted statements like ‘it is known before invention time’ are equivalents to Official Notice. It is noted several references were provided in support of such statements.” Office Action of May 29, 2009 at 29. Applicant respectfully disagrees with this characterization of Examiner Myhre's statements. The Examiner merely references the December 7, 2007 Office Action as containing statements allegedly constituting Official Notice. However, a review of that Office Action reveals that Examiner Myhre only relied upon *Narasimhan* for the rejections made under 35 U.S.C. § 102 and 35 U.S.C. § 103. No other references were provided in support of such statements made by the Examiner, and the Examiner has failed to provide any clarification as to the alleged support such Officially Noticed facts allegedly taken by Examiner Myhre.

Applicant contends that Examiner Myhre never took Official Notice during the prosecution of the present application. Applicant does not find statements such as “it is known before invention time” in Examiner Myhre's rejections, and Examiner Myhre did not rely upon any references other than *Narasimhan* in making his rejections, contrary to the present Examiner's allegations. *See, e.g.*, Advisory Action mailed August 11, 2009. The present Examiner failed to identify any Official Notice taken by Examiner Myhre in the Office Actions mailed December 7, 2007 and April 22, 2008, the Examiner Interview or the Advisory Action mailed July 2, 2008. Prosecution of the present application was turned over to the present Examiner upon filing of the Request for Continued Examination on July 22, 2008. *See id.* Applicant therefore is not aware of any Official Noticed facts taken earlier by

Examiner Myhre and is not aware of a procedure by which the present examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. As such, Applicant respectfully requests that any rejections made with respect to Examiner Myhre's alleged Official Notice be withdrawn.

Further, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 55. The Examiner states that "[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data" and cites several patents as allegedly supporting this assertion. Office Action of May 29, 2009 at 7-8. However, the cited patents fail to teach at least a mobile device having "means for requesting data regarding a promotion from a remote server" or "means for receiving said data from said remote server" as recited in claim 55. For example, *Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Examiner suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. See, e.g., column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Examiner implies. In any event, there is no teaching in *Kolls* of a smart card and a smart card reader/writer being interchangeable with a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in the art so as to allegedly support the Examiner's reasoning related to *Narasimhan* or the alleged Official Noticed facts, and the Examiner failed to respond to Applicant's assertions regarding *Kolls*.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. See, e.g., column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. See, e.g., column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device or wirelessly applying a promotion to a

purchase using a mobile electronic device. The Examiner failed to address Applicant's statements regarding *Freeman*.

In addition, the Examiner's reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited by the Examiner describes later downloading coupons in a portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims. The Examiner asserts that *Aggarwal* allegedly shows "the interchangeability of the several mobile devices to transfer promotion-related data, including using cellphones which clearly are wireless devices." See Office Action of May 29, 2009 at 29. Applicant respectfully maintains that it would not have been obvious to substitute different cell phone devices as disclosed in *Aggarwal* with the smart card of the type set forth in *Narasimhan*, and the Examiner has not provided support to the contrary. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*.

The Examiner has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant maintains that *Leapfrog v. Fisher-Price* is not applicable. The Examiner has failed to show that the references allegedly provide support for the reasoning set forth in the Office Action of May 29, 2009 or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Examiner has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with "modern components" or how the "modern components" allegedly teach what is claimed by Applicant. While the smart card may be carried around by the user, there is no teaching set forth in the reference for incorporating the *Narasimhan* smart card into other mobile devices or updating the smart card with "modern components." As the references cited by the Examiner do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the "unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by *Freeman* or

with a portable phone as taught in Aggarwal” as the Examiner suggests. *See* Office Action of May 29, 2009 at 11-12.

Further, while the Examiner alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.*, Office Action of May 29, 2009 at 7-12), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 55 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action of May 29, 2009 at 9. Further, the Examiner contends that *Aggarwal* is “clear evidence of the Examiner’s assertion of the ‘trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.’” *See* Office Action of May 29, 2009 at 29. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*. As such, Applicant respectfully requests that this rejection be withdrawn.

Again, the Examiner suggests that Applicant has argued that “a mobile device including at least ‘means for applying received promotion when a purchase is made at a point of sale (POS)’ is not disclosed.” *See* Office Action of May 29, 2009 at 14. The Examiner implies that Applicant has previously argued that this limitation is allegedly not disclosed by *Narasimhan*. Rather, in the Amendment Accompanying Request for Continued Examination filed July 22, 2008, Applicant merely stated that the additional art referenced by the Examiner does not teach at least this step. *See* Amendment of July 22, 2008 at 15. Regardless, the Examiner has not shown that this step of claim 55 is taught by *Narasimhan*. The Examiner alleges that Applicant’s argument has been addressed in reference to Claim 41 below. *See* Office Action of May 29, 2009 at 14. Applicant respectfully disagrees.

Claims 56-60 depend directly or indirectly from base claim 55 and thus inherit all limitations of base claim 55. However, each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 56-60 are patentable over the rejection of record.

#### **16. Dependent Claim 58**

*Narasimhan* does not teach that the mobile electronic device is “a mobile telephone and the unique identification is the telephone number” as set forth in claim 58. The Examiner alleges that *Narasimhan* discloses utilizing an Internet or telephone interface. *See* Office Action of May 29, 2009 at 27. However, *Narasimhan* addresses use of these interfaces to describe how the server may be connected to the user’s personal computer, and *not* the form that the smart card may assume. The user generally communicates using his/her personal computer. When the promotion is received, it is only then saved onto the smart card, and there are no input means on the smart card. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. Further, *Narasimhan* discloses Internet or telephone interfaces to describe how the server may be connected to the user’s personal computer, *not* the form that the smart card may assume.

#### **17. Independent Claim 61 and Related Dependent Claims**

Claim 61 recites a system for redeeming promotions comprising, in part, “a wireless mobile electronic device associated with a particular consumer.” *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* is not a wireless mobile electronic device. Rather, the smart card must be physically associated with the user’s personal computer or with the merchant device by swiping or inserting it into a smart card reader/writer. *See, e.g.*, column 7, lines 20-31. As such, the smart card does not operate as a wireless mobile electronic device.

The Examiner states that “[i]t appears Applicant argues *Narasimhan*’s portable card device . . . with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*.” Office Action of May 29, 2009 at 7. The Examiner failed to challenge the statements in *Narasimhan* that



the user of the smart card utilizes a smart card reader/writer to store coupons in a database on the smart card. *See, e.g.*, column 7, lines 23-27. As such, the coupons generated on a user's computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The Examiner asserts that even if the above is conceded, several references allegedly provide support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre. Office Action of May 29, 2009 at 7. Applicant is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the current examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. The Examiner states that “[i]t is noted statements like ‘it is known before invention time’ are equivalents to Official Notice. It is noted several references were provided in support of such statements.” Office Action of May 29, 2009 at 29. Applicant respectfully disagrees with this characterization of Examiner Myhre's statements. The Examiner merely references the December 7, 2007 Office Action as containing statements allegedly constituting Official Notice. However, a review of that Office Action reveals that Examiner Myhre only relied upon *Narasimhan* for the rejections made under 35 U.S.C. § 102 and 35 U.S.C. § 103. No other references were provided in support of such statements made by the Examiner, and the Examiner has failed to provide any clarification as to the alleged support such Officially Noticed facts allegedly taken by Examiner Myhre.

Applicant contends that Examiner Myhre never took Official Notice during the prosecution of the present application. Applicant does not find statements such as “it is known before invention time” in Examiner Myhre's rejections, and Examiner Myhre did not rely upon any references other than *Narasimhan* in making his rejections, contrary to the present Examiner's allegations. *See, e.g.*, Advisory Action mailed August 11, 2009. The present Examiner failed to identify any Official Notice taken by Examiner Myhre in the Office Actions mailed December 7, 2007 and April 22, 2008, the Examiner Interview or the Advisory Action mailed July 2, 2008. Prosecution of the present application was turned over to the present Examiner upon filing of the Request for Continued Examination on July 22, 2008. *See id.* Applicant therefore is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the present examiner can rely on

statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. As such, Applicant respectfully requests that any rejections made with respect to Examiner Myhre's alleged Official Notice be withdrawn.

Further, the references cited by the Examiner to allegedly evidence the level of skill in the art at the time of the invention are insufficient to teach at least this limitation of claim 61. The Examiner states that "[i]t is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data" and cites several patents as allegedly supporting this assertion. Office Action of May 29, 2009 at 7-8. However, the cited patents fail to teach at least "means for receiving from said wireless mobile electronic device associated with said particular consumer an acceptance of said promotion" as recited in claim 61. For example, *Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Examiner suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. *See, e.g.*, column 9, lines 37-38. It does not suggest that the various control means are interchangeable as the Examiner implies. In any event, there is no teaching in *Kolls* of a smart card and a smart card reader/writer being a wireless device nor is there any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. As such, *Kolls* does not evidence the level of skill in the art so as to allegedly support the Examiner's reasoning related to *Narasimhan* or the alleged Official Noticed facts, and the Examiner failed to respond to Applicant's assertions regarding *Kolls*.

Moreover, *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. *See, e.g.*, column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. *See, e.g.*, column 16, lines 9-12; column 17, lines 5-7. Thus, communication, for example, to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, *Freeman* does not evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device or wirelessly applying a promotion to a purchase using a mobile electronic device. The Examiner failed to address Applicant's statements regarding *Freeman*.

In addition, the Examiner's reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited by the Examiner describes later downloading coupons in a portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant's claims. The Examiner asserts that *Aggarwal* allegedly shows "the interchangeability of the several mobile devices to transfer promotion-related data, including using cellphones which clearly are wireless devices." See Office Action of May 29, 2009 at 29. Applicant respectfully maintains that it would not have been obvious to substitute different cell phone devices as disclosed in *Aggarwal* with the smart card of the type set forth in *Narasimhan*, and the Examiner has not provided support to the contrary. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*.

The Examiner has not demonstrated that the above-referenced patents evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. As such, Applicant maintains that *Leapfrog v. Fisher-Price* is not applicable. The Examiner has failed to show that the references allegedly provide support for the reasoning set forth in the Office Action of May 29, 2009 or the alleged Official Noticed facts taken earlier by Examiner Myhre. Moreover, the Examiner has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with "modern components" or how the "modern components" allegedly teach what is claimed by Applicant. While the smart card may be carried around by the user, there is no teaching set forth in the reference for incorporating the *Narasimhan* smart card into other mobile devices or updating the smart card with "modern components." As the references cited by the Examiner do not demonstrate the interchangeability of the smart card device of *Narasimhan* with other user devices, Applicant asserts that it would not have been obvious to replace the "unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by Freeman or with a portable phone as taught in *Aggarwal*" as the Examiner suggests. See Office Action of May 29, 2009 at 11-12.

Further, while the Examiner alleges that it would have been obvious to incorporate the functionality of the smart card into other mobile devices (*see, e.g.*, Office Action of May 29, 2009 at 7-12), Applicant respectfully disagrees. While the smart card may be carried around by the user, there is no teaching or suggestion set forth in the reference for incorporation of the smart card taught in *Narasimhan* into other mobile devices, and thus, the Examiner has not discharged the burden of showing *prima facie* obviousness. Thus, claim 61 should be deemed patentable over the rejection of record.

Moreover, the Examiner states that “it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.” *See* Office Action of May 29, 2009 at 9. Further, the Examiner contends that *Aggarwal* is “clear evidence of the Examiner’s assertion of the ‘trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.’” *See* Office Action of May 29, 2009 at 29. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*. As such, Applicant respectfully requests that this rejection be withdrawn.

Further, claim 61 recites “means for receiving from said wireless mobile electronic device associated with said particular consumer an acceptance of said promotion.” *Narasimhan* fails to teach or suggest this limitation. Even assuming *arguendo* that the smart card of *Narasimhan* is a wireless mobile electronic device, the smart card does not contain any mechanism to wirelessly transmit acceptance of a promotion from the smart card. *See, e.g.*, column 7, lines 10-31. The Examiner asserts that “Examiner Myhre had emphasized earlier that the Examiner considers the selection by the consumer, in *Narasimhan*, of the desired coupons as being an acceptance thereof.” *See* Office Action of May 29, 2009 at 15. Applicant respectfully disagrees. While the consumer in *Narasimhan* may select a desired coupon, such a selection indicating alleged acceptance of the promotion, is not received from a wireless mobile electronic device. Rather, the user in *Narasimhan* clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by employing a smart card reader/writer. *See, e.g.*, column 7, lines 23-27. The Examiner also appears to refer to the combination of *Narasimhan* and *Aggarwal* as allegedly meeting this limitation. *See* Office Action of May 29, 2009 at 14-15. However, the Examiner has not

stated any basis for alleging that this combination of applied references teaches at least this limitation of claim 61 and has not discharged the burden of making a *prima facie* showing of obviousness. Thus, this limitation of claim 61 has not been met.

Claims 62-63 and 65 depend directly or indirectly from base claim 61 and thus inherit all limitations of base claim 61. However, each of these claims set forth features and limitations not recited by the references. Thus, Applicant respectfully asserts that for the above reasons, claims 62-63 and 65 are patentable over the rejection of record.

#### **18. Dependent Claim 63**

Claim 63 recites “means operable in response to communications from said wireless mobile electronic device for coordinating payment for said associated transaction.” *Narasimhan* fails to teach or suggest this limitation. The Examiner alleges that *Narasimhan* discloses “redeeming the promotion at a point of sale (POS) terminal (merchant device) using a payment method controlled by the consumer’s mobile electronic device (credit card).” Office Action of May 29, 2009 at 26. However, the smart card of *Narasimhan* does not send communications for the system to respond to for coordinating payment for an associated transaction, and the Examiner failed to address this limitation of claim 63. Rather, the smart card of *Narasimhan* merely acts as a traditional credit or debit card for payment purposes. *See, e.g.*, column 7, lines 50-59.

#### **19. Independent Claim 66 and Related Dependent Claims**

Independent claim 66 recites a system for coordinating transactions comprising, in part, “means for coordinating said received information from a wireless mobile electronic device of a specific one of said users with information available to said server pertaining to said unique merchant location.” *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* is not a wireless mobile electronic device. Further, the system in *Narasimhan* does not receive information specific to one of many merchants directly from the smart card. Rather, a smart card reader/writer must be connected to the merchant device and the smart card swiped or inserted into the smart card reader/writer to allow the merchant device to communicate to the server information about, for example, the POS location of the merchant. *See, e.g.*, column 7, lines 27-37. Thus, information is not received from the smart

card and coordinated with information available to said server pertaining to said unique merchant location. Accordingly, this limitation of claim 66 has not been met.

Claim 66 further recites “means for communicating at least a portion of said coordinated information to said wireless mobile electronic device of said one user over said temporarily established connection, said coordinated information including promotional information associated with said specific user.” *Narasimhan* fails to teach or suggest this limitation. The system of *Narasimhan* does not include means to communicate coordinated information including promotional information associated with the specific user to the smart card. Rather, promotional information is saved onto the smart card which is physically associated with the user’s personal computer through a smart card reader/writer when the user receives the promotional information on his/her personal computer. *See, e.g.*, column 6, lines 30-57; column 7, lines 10-31. Accordingly, independent claim 66 should be deemed patentable over the rejection of record.

Claims 67-69 depend directly or indirectly from base claim 66 and thus inherit all limitations of base claim 66. Each of these claims set forth features and limitations not recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 67-69 are patentable over the rejection of record.

## **20. Dependent Claim 68**

Claim 68 recites “means at said server for accepting further information from said wireless mobile electronic device of said one user, said further information comprising acceptance information for both said cost information and said promotion information.” *Narasimhan* does not teach these limitations as any communication that the smart card user has occurs via action by the merchant device or the user’s personal computer, not the smart card. *See, e.g.*, column 6, lines 30-36 and 52-57; column 7, lines 27-37. *Narasimhan* fails to teach or suggest this limitation as the smart card does not send further information including acceptance information to means at the server. Rather, it is the merchant device that communicates information such as acceptance information to the server. *See, e.g.*, column 7, lines 32-37.

**21. Dependent Claim 69**

Claim 69 recites “means at said server for coordinating payment to said one merchant from said one user, said payment based upon said information communicated to said wireless mobile electronic device of said user and said acceptance information from said wireless mobile electronic device of said user.” However, *Narasimhan* fails to teach or suggest this limitation as payment is not coordinated based on information sent from the smart card to the server but rather based on information transmitted from the merchant device. *See, e.g.*, column 7, lines 32-37. *Narasimhan* does not teach these limitations as any communication that the smart card user has occurs via action by the merchant device or the user’s personal computer, not the smart card. *See, e.g.*, column 6, lines 30-36 and 52-57; column 7, lines 27-37.

**22. Independent Claim 70 and Related Dependent Claims**

Independent claim 70 recites a method for coordinating transactions comprising, in part, “coordinating said received information from said wireless mobile electronic device specific one of said users with available information pertaining to said unique merchant location.” *Narasimhan* fails to teach or suggest this limitation. The smart card of *Narasimhan* is not a wireless mobile electronic device. Further, the system in *Narasimhan* does not receive information specific to one of many merchants directly from the smart card. Rather, a smart card reader/writer must be connected to the merchant device to allow the merchant device to communicate to the server information about, for example, the POS location of the merchant. *See, e.g.*, column 7, lines 27-37. Thus, information is not received from the smart card and coordinated with information available to said server pertaining to said unique merchant location. Accordingly, this limitation of claim 70 has not been met.

Independent claim 70 further recites “communicating at least a portion of said coordinated information to said wireless mobile electronic device of said one user over said temporarily established wireless communication connection, said coordinated information including promotions available to said specific one of said users pertaining to said obtained merchandise.” *Narasimhan* fails to teach or suggest this limitation. The system of *Narasimhan* does not communicate coordinated information including promotional

information associated with the specific user to the smart card. Rather, promotional information is saved onto the smart card which is physically associated with the user's personal computer through a smart card reader/writer when the user receives the promotional information on his/her personal computer. *See, e.g.*, column 6, lines 30-57; column 7, lines 10-31. Accordingly, independent claim 70 should be deemed patentable over the rejection of record.

The Examiner suggests that Applicant has previously presented arguments that the limitation of "accepting over a temporarily established communication connection from a wireless mobile electronic device of any one of a plurality of users information specific to one of many merchants, said information including data specific to a unique location of one of said merchants, said specific data pertaining to merchandise obtained from said merchant" is not disclosed in *Narasimhan*. *See* Office Action of May 29, 2009 at 23-24. Applicant respectfully disagrees as Applicant did not previously present this argument with respect to *Narasimhan*. Rather, in the Amendment Accompanying Request for Continued Examination filed July 22, 2008, Applicant merely stated that the additional art referenced by the Examiner does not teach at least this step. *See* Amendment of July 22, 2008 at 15-16. Regardless, the Examiner has not shown that this step of claim 70 is taught by *Narasimhan*. More specifically, the smart card of *Narasimhan* does not send any one of a plurality of users information specific to one of many merchants over a temporarily established wireless communication connection. Rather, the user clips the coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by employing a smart card reader/writer. *See, e.g.*, column 7, lines 23-27. Thus, this limitation of claim 70 is not taught by *Narasimhan*.

The Examiner also appears to assert that the combination of *Narasimhan* and *Aggarwal* allegedly teaches this limitation of claim 70. *See* Office Action of May 29, 2009 at 23-24. However, the Examiner failed to set forth a *prima facie* case of obviousness as no reasons are provided for asserting that this combination of applied references allegedly teaches this limitation of claim 70.

Claims 71-73 depend directly or indirectly from base claim 70 and thus inherit all limitations of base claim 70. Each of these claims set forth features and limitations not



recited by these references. Thus, Applicant respectfully asserts that for the above reasons, claims 71-73 are patentable over the rejection of record.

**23. Dependent Claim 72**

Claim 72 recites “accepting further information from said wireless mobile electronic device of said one user, said further information comprising acceptance information for said cost information and for said promotion.” *Narasimhan* does not teach these limitations as any communication that the smart card user has occurs via action by the merchant device or the user’s personal computer, not the smart card. *See, e.g.*, column 6, lines 30-36 and 52-57; column 7, lines 27-37. *Narasimhan* fails to teach or suggest this limitation as the smart card does not send further information including acceptance information to the system. Rather, the merchant device communicates any information to the server. *See, e.g.*, column 7, lines 32-37.

**24. Dependent Claim 73**

Claim 73 recites “coordinating payment to said one merchant from said one user, said payment based upon said information communicated to said wireless mobile electronic device of said user and said acceptance information from said wireless mobile electronic device of said user, including acceptance or rejection of said promotion.” However, *Narasimhan* fails to teach or suggest this limitation as payment is not coordinated based on information sent from the smart card to the server but rather based on information transmitted from the merchant device. *See, e.g.*, column 7, lines 32-37. *Narasimhan* does not teach these limitations as any communication that the smart card user has occurs via action by the merchant device or the user’s personal computer, not the smart card. *See, e.g.*, column 6, lines 30-36 and 52-57; column 7, lines 27-37.

**VIII. CLAIMS APPENDIX**

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

**IX. EVIDENCE APPENDIX**

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

**X. RELATED PROCEEDINGS APPENDIX**

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.

Dated: October 30, 2009

Respectfully submitted,

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**APPENDIX A**

**Claims Involved in the Appeal of Application Serial No. 10/691,459**

1. A method for distributing a promotion, said method comprising:  
generating said promotion for use by a specific consumer;  
wirelessly transmitting data relating to said promotion to a mobile electronic device of said specific consumer; and  
wirelessly applying said promotion to a purchase using said mobile electronic device.
2. The method of claim 1 wherein said promotion is a coupon, a discount, an alert, or an offer to sell.
3. The method of claim 1 further comprising:  
receiving a response from said mobile electronic device of said specific consumer redeeming said promotion, wherein said response is received wirelessly.
4. The method of claim 3 further comprising:  
processing each said redemption in accordance with rules established by a merchant associated with said promotion redemption.
5. The method of claim 1 further comprising:  
storing said promotion in an electronic account for later use by said consumer, wherein said electronic account is accessible by said consumer at a point of sale.
7. The method of claim 1 wherein said transmitted data is a text message.
8. The method of claim 1 wherein said transmitted data is a voice mail message.
9. The method of claim 1 wherein said promotion is generated based upon a request made by said consumer.
10. The method of claim 1 wherein said promotion is generated using a profile of said consumer.

11. The method of claim 1 wherein said application of said promotion is automatic.
12. The method of claim 1 further comprising:  
identifying said consumer by identifying said mobile electronic device.
13. A method of wirelessly receiving and redeeming promotions via a mobile electronic device, said method comprising:  
accessing, with said mobile electronic device, data, relating to said promotion, wirelessly transmitted to said mobile electronic device from a server;  
redeeming said promotion by wirelessly replying to said server using said mobile electronic device; and  
saving said redeemed promotion to an electronic account.
14. The method of claim 13 wherein said promotion is a coupon, a discount, an alert, or an offer to sell.
16. The method of claim 13 wherein said consumer wirelessly requests said promotion from said server by using said mobile electronic device.
17. The method of claim 13 wherein said server generates said promotion based, in part, on a merchant profile and on a consumer profile.
18. The method of claim 13 wherein said electronic account is remotely accessible by said consumer.
19. The method of claim 13 wherein said redeeming occurs at a point of sale (POS) and wherein said POS uses a payment method controlled, at least in part, by said mobile electronic device.
20. The method of claim 19 wherein said promotion is automatically applied to a purchase when said purchase is made using said mobile electronic device.
21. The method of claim 13 wherein said redeeming is by telephone, text message, or multi-media message.

22. A method of distributing a promotion, said method comprising:  
generating said promotion for use by a consumer;  
sending promotion data to a consumer web portal account wirelessly accessible on a mobile electronic device of said consumer; and  
saving said promotion in a promotion saving account accessible by said mobile electronic device wherein said consumer wirelessly redeems said promotion using said mobile electronic device for a purchase at a point of sale (POS).

26. A method for wirelessly distributing a promotion to a mobile electronic device of a targeted consumer, said method comprising:  
generating said promotion for use by said targeted consumer, wherein said targeted consumer is selected from a plurality of potential consumers; and  
wirelessly transmitting data relating to said promotion to said mobile electronic device of said targeted consumer.

27. The method of claim 26 wherein each of said potential consumers has a consumer profile and said targeted consumer is selected based on said targeted consumer's consumer profile.

28. The method of claim 27 wherein said consumer profiles are stored in a consumer profile database.

29. The method of claim 28 wherein a merchant selects at least one characteristic related to said consumer profiles of said potential consumers and distributes said promotion to each potential consumer having said characteristic in their said consumer profile.

30. A method of wirelessly distributing a promotion to a mobile electronic device of a requesting consumer, said method comprising:  
generating said promotion for use by said requesting consumer, wherein said requesting consumer is prompted to request said promotion; and  
wirelessly transmitting data relating to said promotion to said mobile electronic device of said requesting consumer.

31. The method of claim 30 wherein said requesting consumer is prompted by an advertisement.

32. The method of claim 31 wherein said advertisement is a billboard, a radio advertisement, a television advertisement, or a newspaper advertisement.

33. The method of claim 30 wherein said requesting consumer contacts a distributor to request said promotion using said mobile electronic device.

34. The method of claim 33 wherein said distributor comprises a promotion distributing server.

35. The method of claim 34 wherein said requesting consumer contacts said distributor via said mobile electronic device by calling a telephone number, sending an email message, or sending a text message.

36. The method of claim 30 wherein said promotion is stored for later use by said consumer.

37. A method for distributing a promotional offer to a targeted consumer, said method comprising:

wirelessly transmitting said offer to a mobile electronic device of said targeted consumer, wherein said targeted consumer is selected from a plurality of potential consumers;

receiving a reply from said mobile electronic device of said targeted consumer in response to said promotional offer; and

facilitating a purchase by said targeted consumer, said purchase correlated to said promotional offer.

38. The method of claim 37 wherein each of said potential consumers has a consumer profile and wherein said targeted consumer is selected based on said targeted consumer's consumer profile.

39. The method of claim 38 wherein said consumer profiles are stored in a consumer profile database.

40. The method of claim 39 wherein a merchant selects at least one characteristic of said consumer profiles of said potential consumers and distributes said promotional offer to each potential consumer having said characteristic in their said consumer profile.

41. A system for distributing and redeeming a promotion, said system comprising:  
a processor for generating promotion data;  
a mobile electronic device operable for wirelessly transmitting a request for promotional data and for wirelessly receiving generated promotion data; and  
a database accessible by said processor, said database operable in conjunction with said processor for storing information used for generating said promotion.

44. The system of claim 41 further comprising:  
a merchant database accessible by said processor, and operable to store information associated with at least one merchant used to generate said promotion.

45. The system of claim 41 further comprising:  
a consumer database accessible by said processor and operable to store information associated with at least one consumer and used to generate said promotion.

46. The system of claim 41 further comprising:  
a consumer database wherein said promotion can be stored for later redemption by said consumer.

47. The system of claim 41 wherein said system utilizes extensible mark-up language (XML) or Java 2 Platform, Enterprise Edition (J2EE) technology.

48. The system of claim 41 wherein said system has an Internet interface.

49. A method for consumer contact, said method comprising:  
accessing a consumer database containing at least one profile of at least one consumer;  
transmitting, to a mobile electronic device of a consumer, data relating to a promotion, wherein said promotion is generated from the profile of said consumer; and  
matching said promotion with a merchant profile in a merchant profile database when said consumer redeems said promotion by wirelessly communicating using said mobile electronic device in an electronic purchase.

50. The method of claim 49 wherein said promotion is a coupon, a discount, an alert, or an offer to sell.

52. The method of claim 49 wherein buying habits of said consumer are recorded in said consumer profile.

53. The method of claim 49 wherein said promotion is generated using said consumer buying habits.

54. The method of claim 49 further comprising:  
receiving by said processor consumer requests for promotions transmitted from said mobile electronic device of said consumer.

55. A mobile electronic device comprising:  
means for requesting data regarding a promotion from a remote server;  
means for receiving said data from said remote server; and  
means for applying received promotion data when a purchase is made at a point of sale (POS).

56. The device of claim 55 further comprising:  
means for storing information related to said promotion; and  
means for reading said stored promotion information at said POS.

57. The device of claim 55 wherein said device is uniquely identifiable by said remote server.

58. The device of claim 57 wherein said device is a mobile telephone and the unique identification is the telephone number.

59. The device of claim 55 wherein said requesting and said receiving means utilize dual-tone multi-frequency (DTMF) technology.

60. The device of claim 55 wherein said device is capable of text messaging and wherein said requesting and receiving means utilize extensible mark-up language (XML) or Java 2 Platform, Enterprise Edition (J2EE) technology.



61. A system for redeeming promotions, said system comprising:  
means for identifying a redeemable promotion;  
a wireless mobile electronic device associated with a particular consumer; and  
means for receiving from said wireless mobile electronic device associated with said particular consumer an acceptance of said promotion.

62. The system of claim 61 wherein said identifying means comprises:  
means for associating a particular transaction at a point of sale (POS) with said redeemable promotion; and  
means for communicating said associated transaction to said wireless mobile electronic device associated with said particular consumer.

63. The system of claim 62 further comprising:  
means operable in response to communications from said wireless mobile electronic device for coordinating payment for said associated transaction.

65. The system of claim 61 wherein said wireless mobile electronic device is a cell phone.

66. A system for coordinating transactions, said system comprising:  
a server for accepting over a temporarily established communication connection from anyone of a plurality of users information specific to one of many merchants, said information including data specific to a unique POS location of one of said merchants;  
means for coordinating said received information from a wireless mobile electronic device of a specific one of said users with information available to said server pertaining to said unique merchant location;  
means for communicating at least a portion of said coordinated information to said wireless mobile electronic device of said one user over said temporarily established connection, said coordinated information including promotional information associated with said specific user; and  
means for coordinating the redemption of the promotion associated with said promotional information.

67. The system of claim 66 wherein said information to said one user comprises: cost information pertaining to said information obtained from said specific location, said cost information discounted by said promotion information.

68. The system of claim 67 further comprising:  
means at said server for accepting further information from said wireless mobile electronic device of said one user, said further information comprising acceptance information for both said cost information and said promotion information.

69. The system of claim 68 further comprising:  
means at said server for coordinating payment to said one merchant from said one user, said payment based upon said information communicated to said wireless mobile electronic device of said user and said acceptance information from said wireless mobile electronic device of said user.

70. A method for coordinating transactions, said method comprising:  
accepting over a temporarily established wireless communication connection from a wireless mobile electronic device of any one of a plurality of users information specific to one of many merchants, said information including data specific to a unique location of one of said merchants, said specific data pertaining to merchandise obtained from said merchant;  
coordinating said received information from said wireless mobile electronic device specific one of said users with available information pertaining to said unique merchant location; and  
communicating at least a portion of said coordinated information to said wireless mobile electronic device of said one user over said temporarily established wireless communication connection, said coordinated information including promotions available to said specific one of said users pertaining to said obtained merchandise.

71. The method of claim 70 wherein said information to said one user comprises: cost information pertaining to said information obtained from said specific location, said cost information including any modifications thereto based upon said communicated promotion.

72. The method of claim 71 further comprising:

accepting further information from said wireless mobile electronic device of said one user, said further information comprising acceptance information for said cost information and for said promotion.

73. The method of claim 72 further comprising:

coordinating payment to said one merchant from said one user, said payment based upon said information communicated to said wireless mobile electronic device of said user and said acceptance information from said wireless mobile electronic device of said user, including acceptance or rejection of said promotion.

**APPENDIX B**

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Appellee is being submitted.

**APPENDIX C**

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.